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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/038,572	03/11/98	HINUMA	45753-DIV

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HM22/0628

EXAMINER	
GUPTA, A	
ART UNIT	PAPER NUMBER
1654	7

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 06/28/99

- ☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_ ☐ This action is made final.  
For Restriction Purposes only

A shortened statutory period for response to this action is set to expire 3 Months from the date of this letter.  
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449              | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-18 are pending in the application.  
Of the above claims, \_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_ are objected to.
6. ☒ Claims 1-18 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_ has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_; filed on \_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

09/038,572

*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 10-12, drawn to nucleotide sequence, classified in class 536, subclass 23.1.
  - II. Claims 2-4, drawn to a method of amplifying DNA coding, classified in class 435, subclass 89.
  - III. Claims 5-9, drawn to protein or protein fragments, classified in class 530, subclass 350+.
  - IV. Claim 13, drawn to a transformant containing a vector, classified in class 435, subclass 243+.
  - V. Claim 14, drawn to method of determining a ligand to a G-protein coupled receptor, classified in class 436, subclass 501.
  - VI. Claim 15, drawn to a method of determining a compound capable of inhibiting binding of G-protein to a ligand, classified in class 436, subclass 86+.
  - VII. Claim 16-17, drawn to a compound which is capable of inhibiting binding of G-protein to a ligand, classified in class 514, subclass 2+.
  - VIII. Claim 18, drawn to a ligand that binds G-protein, classified in class 514, subclass 2+.
2. The inventions are distinct, each from the other because of the following reasons:

The inventions of Group I, III, IV, VII and VIII are distinct in that the compounds of each group will be structurally distinct and therefore are independent of one another. Group IV is drawn to a microorganism whereas the inventions of Group I, VII and VIII are drawn to compounds. Groups II and V and VI are distinct in that the method of Group II involves a polymerase chain reaction. This reaction step is not required for the method of Group V and VI. Finally, Group V and VI are distinct from one another in that the method of Group VI requires the use of a ligand. Since Group V is screening for the desired ligand, the screening methods would be distinct.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for another Group, restriction for examination purposes as indicated is proper.

5. Claims 1, 10-12 of Group I, claims 5-9 of Group III, claims 16-17 of Group VII and claim 18 of Group VIII are generic to a plurality of disclosed patentably distinct species comprising

- a) The DNA sequences corresponding to SEQ ID 1 to 19 for claims 1, 10-12.
- b). The protein or protein fragments corresponding to SEQ ID. 24, 25, 26, 27, 28, 34-35, 38-39, and 56 for claims 5-9.
- c) A single disclosed compound which is capable of inhibiting binding of G-protein to a ligand for claims 16-17.
- d) A single ligand that binds G-protein for claim 18

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicants should note that if applicants elect Group I, applicants are requested to elect a single disclosed species corresponding to SEQ. ID 1 to 19. If applicants elect Group III, applicants are requested to elect a single disclosed species corresponding to SEQ ID. 24, 25, 26, 27, 28, 34-35, 38-39, and 56 or a single disclosed fragment thereof etc... Applicants are requested to elect a single disclosed compound if the elect Group VII or VIII.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

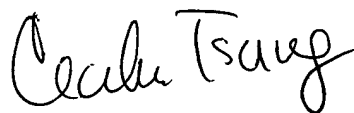
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can normally be reached on (703) 308-0254. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Anish Gupta



Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600